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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,409	03/28/2002	Hideki Aikoh	10873.882USWO	4963
53148	7590	09/13/2005	EXAMINER	
HAMRE, SCHUMANN, MUELLER & LARSON P.C. P.O. BOX 2902 MINNEAPOLIS, MN 55402			DINH, TAN X	
			ART UNIT	PAPER NUMBER
			2653	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,409

Applicant(s)

AIKOH ET AL.

Examiner

TAN X. DINH

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/10/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1) The amendment filed 7/07/2005 is acknowledged. Claims 7 and 15-17 have been canceled. New claims 18-20 are currently been added.

2) The I.D.S filed 6/10/2005 has been partially considered by the Examiner.

The information disclosure statement filed 6/10/2005 *fails* to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document. The foreign patent document identifies as 0-863-503 (E.P.O), September 1998, has not been considered at this time since no copy has been submitted. Applicant is required to re-submitted another form PTO-1449 and the copy of this document in next communication for consideration.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) Claims 12-14 and 18-20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not reference to two sets of claims to different features (claims 12-14 and 18-20 recite an optical disk device for recording and reproducing which different feature of optical disk of read-only or partial ROM of claims 1-4). See MPEP § 608.01(n). Accordingly, the claims 12-14, 18-20 are not been further treated on the merits.

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4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6) Claims 1, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAGATAKI et al (5,527,479).

The rejection of claims 1,3 and 5 in previously office action is repeated herein.

7) Claims 2,4,6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAGATAKI et al (5,527,479) further in view of KAMEZAKI et al (5,904,969).

The rejection of claims 2,4,6-11 in previously office action is repeated herein.

8) Applicant's arguments filed 7/07/2005 have been fully considered but they are not persuasive.

First, applicant states that the reference of NAGATAKI et al teaches a recording medium having protective layer coats with silicone oil for use in low speed and the invention of claims 1,3 and 5 aimed at high speed seeking by modifying the viscosity of silicone oil. However, the features upon which applicant relies (i.e., high speed seeking by modifying the viscosity of silicone oil) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further, the optical recording medium of NAGATAKI et al having the same structures as applicant's medium, the protective layer coats with *silicone oil* which is the same as applicant's protective layer, therefore, the protective layer of NAGATAKI et al is fully capable to perform the same functions as applicant's protective layer (high speed, low speed, suited for a floating-type magnetic head used for a magnetic field modulation type magneto-optical disk or a protective layer suited for a sliding-type magnetic head used for the magnetic field modulation type magneto-optical disk).

Second, the printing layer is widely used in the optical recording art for labeling the medium, the label layer can be located at any suitable locations in the medium. For example, every CD for sale in the market includes a label layer for displaying the name of the CD, the name of artist, etc.,. The read-only disk or partial recording disk are old and well known in the art as indicated in previously office action. To use these well known features in NAGATAKI et al and KAMEZAKI et al as claimed is deem obvious to someone within the level of skill in the art.

For those reasons, the claims are still rejectable as shown above.

9) THIS ACTION IS MADE FINAL. Applicant is reminded of the

extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See form PTO-892 attached herein).

TOKUDA (JP, 7-044912), KOMAKI et al (5,568,466) and KAWANO (6,625,107) disclose a magneto-optical recording medium having the protective layer coats with silicone oil.

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN XUAN DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY-FRIDAY from 8:00AM to 5:00PM.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

September 9, 2005